

### REMARKS

Currently pending Claims 1 and 2 stand rejected based on Tanaka, U.S. Patent No. 5,266,931. During the December 20, 2004 interview, Applicant and Examiner reached agreement that Tanaka does not teach the inventions as claimed by Applicant because Tanaka does not disclose or enable the claims as recited.

Applicant recites and claims a method and apparatus which includes, as with respect to Claim 1:

un-highlighting a first button when a finger which is still touching the screen exits the enlarged sensitive area of said first button without being released, and, when finger touch is sensed from finger placement on or finger sliding on a visually defined boundary for a second button with said previously highlighted first button being unhighlighted, activating the enlarged sensitive area for said second button and concurrently highlighting the visually defined boundary for said second highlighted button.

As discussed with the Examiner, Tanaka does not teach or disclose this ability to select a second menu item after initially touching a first menu item.

Tanaka discloses a system whereby a user selects a certain menu item, from multiple possible items, in a "pen-down" action. At that time, the system determines the menu item which was touched by the pen-down action and establishes and saves the x-y coordinates of the selected item. That particular menu item is then highlighted for visual indication of selection, and a second region, similar in shape but larger and surrounding the selected menu item, is established. See col. 3, lns. 28-40. If the pen is

lifted within the second region, the menu item is settled and entered. Col. 4, Ins. 38-49. If, however, the pen is moved outside of the second region and then lifted, no data is selected or input into the system. See col. 4, Ins. 26-36.

Tanaka does not disclose or enable a system which allows a user to initially select a menu item and then, while maintaining "pen-down," cancel that selection and choose another item. The inability of Tanaka to allow a user to select a second menu item after initially selecting a first menu item is demonstrated most clearly in Tanaka '931 at col. 4, ln. 58 to col. 5, ln. 15. As stated therein,

Upon detection of a pen-down action to the first region of a desired button, a decision is made as to which button has been depressed, and the depressed button (first region) is displayed as a reversal image. In case any wrong button is displayed due to an erroneous depression or insufficient detection precision, the input manipulation can be canceled by first shifting the pen from the down-position to the outside of the second region and then lifting up the pen therefrom.

Even if the pen is accidentally displaced to the outside of the first region by some shake of the user's hand or the like, the selected input is retained effective unless the pen is displaced beyond the second region which is dimensionally greater than the first region. And even when the reversal image of the button is deleted with a displacement to the outside of the second region, the reversal image of the button is displayed again by reverting the pen to the first region while holding the pen in its down-state, whereby the input is accepted.

Tanaka '931, at col. 4, ln. 58 to col. 5, ln. 8 As shown in Figure 5 of Tanaka, each respective "second region" of each menu item in Tanaka overlaps the physical space of each respective adjacent menu item. See Tanaka Fig. 5. So, if a user initially selects the 5-key, as shown in Figure 5, then slides the pen outside of the 5-key second region and onto the adjacent 3-key, the 5-key becomes unhighlighted. See col. 4, Ins. 26-36, and Figure 5. If, as the Examiner originally stated in the August 25, 2004 Office Action,

the 3-key in that situation became highlighted, a fatal error would occur. If the 3-key is at that time highlighted and, as Tanaka expressly states,

the reversal image of the [original 5-key] button is displayed again by reverting the pen to the first region while holding the pen in its down-state,

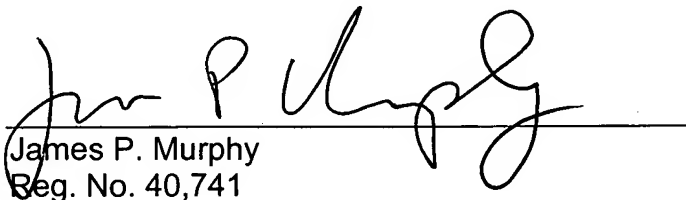
then both the 3-key and the 5-key would be highlighted when the pen is within the area of the 5-key shared by the "second region" of the 3-key. See Tanaka '931, Figure 5. This is not a proper reading of the teaching of Tanaka, and would render Tanaka non-workable. Thus, the Examiner's original description of Tanaka, in the August 25, 2004 Office Action, is not taught or enabled by Tanaka.

At the December 20, 2004, Interview, the Applicant and the Examiner reached agreement as to Tanaka. See Interview Summary. Agreement was reached that Tanaka does not disclose or enable the invention as recited by Applicant. As such, Applicant requests that the rejection of Claims 1 and 2 be withdrawn, and that the Examiner issue a Notice of Allowance of pending Claims 1 and 2.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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